

REMARKS

Upon entry of the amendments, claims 12, 14-16, 28-32, 39 and new dependent claims 40-41 will be pending. Claim 12 and some dependent claims have been amended to expedite prosecution and for clarity. The amendments and new claims are supported at least in the specification on page 4, last paragraph, through page 5, line 5; in pages 16-19 and 21; in the Examples; and in the claims as originally filed. No new matter has been added.

All of the previous grounds of rejection have been withdrawn, and new grounds of rejection have been cited, each of which is addressed below. Applicant respectfully requests reconsideration and allowance of the amended claims in view of the remarks below.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 12, 14-16, 28-32 and 39 are rejected as allegedly being incomplete for omitting essential elements. In particular, the Office alleges that “the lack of a method step for assaying for the kinase activity of IP3KB, or for the level of IP3KB polypeptide/gene expression product in the cell, is an omission that renders the claims incomplete.” (Office Action, pages 3-4). Applicant has amended the claims to expedite prosecution without acquiescing to the Examiner’s arguments. Applicant submits that the amended claims are complete and definite, and respectfully requests that these rejections be withdrawn.

Rejections under 35 U.S.C. § 112, first paragraph

Claim 39 is rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing new matter. In particular, the Examiner alleges that “it appears that the specification only contemplates testing the agents in non-human animals by removing the thymus after administering the test agent.” (Office Action, page 3). Applicant respectfully disagrees. The specification specifically states that the invention provides methods for modulating T cell development in a subject, including human and animals such as other mammals. (See, specification age page 5, lines 3-4). Thus, Applicant respectfully submits that claim 39 is supported by the specification, and requests that this rejection be withdrawn.

Furthermore, the Office alleges that the specification does not enable claims 12, 14-16, 28-32 and 39 as broadly claimed. However, the Office acknowledges that the specification is enabling for:

“[A] method comprising assaying IP3KB kinase activity in the presence of a test agent, or assaying the level of IP3KB polypeptide or IP3KB gene expression in a cell in the presence of a test agent, followed by identifying one or more agents that

inhibits the kinase activity of IP3KB, or inhibits the cellular level of IP3KB polypeptide or IP3KB gene expression.” (Office Action, page 4).

To expedite prosecution, claim 12 has been amended to encompass subject matter that the Office has acknowledged the specification is enabling for.

Based on the above, claims 12, 14-16, 28-32 and 39 are in compliance with 35 U.S.C. § 112, first paragraph. Thus, Applicant respectfully requests that these rejections be withdrawn.

New dependent claims 40-41

New dependent claims 40-41 contain all the limitations of claim 39, which depends upon claim 12, and are novel and enabled.

Conclusion

In summary, the claims have been amended to obviate the rejections, and Applicant requests that claims 12, 14-16, 28-32 and 39-41 be passed to issue. If a telephone conference would expedite prosecution of this application, please telephone the undersigned attorney at (858) 812-1539.

If the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 50-1885 referencing docket No. P1097US10.

Respectfully submitted,

/Emily Tongco Wu, Reg. No. 46,473/

Emily Tongco Wu, Ph.D.
Reg. No. 46,473

Dated: October 22, 2008

Customer No.: 29490
Tel: (858) 812-1539
Fax: (858) 812-1909